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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,191	11/28/2000	Satoshi Machino	70868-55282	7748
21874	7590	06/30/2005	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			DALENCOURT, YVES	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,191

Applicant(s)

MACHINO ET AL.

Examiner

Yves Dalencourt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-29 is/are allowed.
- 6) ☒ Claim(s) 21-23 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to Request for continued Examination (RCE) filed on 06/08/2005.

Response to Amendment

The examiner has acknowledged the amended claims 21, 24, 27, and 30, and the amended specification. The objection of the specification under 35 U.S.C. 132 and the rejection of claims 24 – 29 under 35 U.S.C. 112, first paragraph have been withdrawn.

Response to Arguments

Applicant's arguments, see pages 7 - 10, filed on 06/08/2005, with respect to the rejection(s) of claim(s) 24 - 29 under 35 U.S.C. 112, first paragraph and claims 21 – 23 and 30 – 34 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection to claims 21 – 23 and 30 – 34 is made in view of US Patent 6,823,368.

Specification

The disclosure is objected to because of the following informalities. It is suggested to insert a complete sentence in the amended paragraph (see lines 5 – 6). Appropriate correction is required.

Claim Objections

Claim 27 is objected to because of the following informalities: It is suggested to delete " an " before user (claim 27, line 2) and insert – a --. Appropriate correction is required.

Priority

The examiner is aware that the priority date of this application beats the filing date of US Patent No. 6,823,368. However, Applicants are required to send a certified translation of the Japanese Patent Application No. P11-343621 in order to claim right of priority. By doing so, the prior art No. 6,823,368 uses in this office action will be withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 – 23 and 30 - 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iida Hiroshi (JP-A 5-219103; hereinafter Iida) in view of Ullmann et al (US 6,823,368; hereinafter Ullmann).

Regarding claims 21, 23, and 30, Iida teaches a method and apparatus for composing electronic mail message (fig. 1) comprising the steps of composing a body of a message (paragraph [0013]; Iida discloses that a user can input a message or can set up various kinds of conditions, which reads on the claim limitation since applicant

fails to mention that such step is being done without user's intervention); selecting registrant data for a prescribed area (paragraph [0014]; lida discloses that if a group's destination is described here, email will be transmitted to the each people destination belonging to the group); selecting attributes and a setting for association with the body of the message, the attributes and the setting for determining a list of recipients of the message according to the registrant data in the prescribed area (paragraphs [0015] and [0019]; lida discloses that when the group destination is described by destination information, once developing the group destination described by the individually-addressed point group, this individually-addressed point is replaced with the group destination described by the destination information in an e-mail sheet, and mail for the number which should transmit is create); and sending the message to the list of recipients (paragraph [0016]; paragraph [0019], lines 11 – 12; and paragraph [0020]; lida discloses that mail for the number which should transmit original mail had been created by this. The usual transmitting processing is performed at the step after this).

Lida teaches substantially all the limitations, except for the idea of determining a list of recipients of the message automatically or without user intervention.

However, Ullmann teaches, in the same field of endeavor, a method and system for email sender chain history by adding a sender-chain filed to the e-mail header when forwarding a chain forwarded e-mail message to another recipient, which comprises the idea of determining a list of recipients of the message automatically or without user intervention (col. 5, lines 6 – 14 and lines 33 – 45).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lida by determining a list of recipients of the message automatically or without user intervention for the purpose of managing sender address information in an efficient manner, thereby providing an enhanced e-mail reader and composer having automatic addressing functions.

Regarding claim 22, Lida and Ullmann teach all the limitations in claim 21, and lida further teaches a method for composing electronic mail message (fig. 1), wherein the attributes are a group name, file name and template (paragraphs [0009 – 0014]).

Regarding claims 31 - 34, Lida and Ullmann teach all the limitations in claim 21, and lida further teaches a method for composing electronic mail message (fig. 1), wherein the first, second and third means is a desktop computer, and wherein the first means is a computer in communication with a distributed computing network (paragraphs [0009 – 0011]).

Allowable Subject Matter

Claims 24 – 29 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: As specifically claimed, the art of record fail to teach, among other limitations, in combination, a processor being in communication with the memory and the distributed computing network, wherein the processor is operative to read a setting and a group name from attribute information associated with an electronic mail message; determine the plurality of registrants associated with the group name; detect destinations in a

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prescribed region of the electronic mail message; classify the plurality of registrants into a first group associated with the group name and a second group not associated with the group name; determine a list of recipients for the electronic mail message according to a rule associated with the setting, the rule being for determining whether the first and second groups receive the electronic mail message; and transmit the electronic mail message to the list of recipients.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt



June 27, 2005